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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HARVEY, DAVID E

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

12/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,971	Applicant(s) BERNSEN ET AL.	
	Examiner DAVID E. HARVEY	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The preamble of claim 10 indicates that claim 10 is directed to an apparatus that is "adapted to" perform the various functional recitations that are recited in lines 3-12 of said claim 10. The following is noted:

1) The claim is indefinite because the body of the claim fails to recite any "structure" pertaining to the recited "apparatus" of the preamble; and

2) That terms such as "adapted to" have been held only referring to a capability to perform the recited function and not to structure that actually performed the function.

Similar clarification is needed in claim 11.

B) Line 1 of claim 8 recites, "a record carrier comprising a data stream." It is unclear from the disclosure as to whether the recited "record carrier" refers to computer readable storage memories or whether this terminology encompasses carrier "signals" too [note lines 25-28 of page 5 of the instant disclosure]. In any event, when the terminology is construed as being directed to a computer readable memory, the "comprising" recitation appears to be misdescriptive because such a memory is a structure and does not "comprise" data streams; rather, the data stream is recorded/encoded/stored in or on the memory. Similar clarification is needed in line 1 of claim 9.

C) In claim 9, line 2, the term "enable the computer" is indefinite because it is not clear whether the recited "record carrier" has "instructions" that, when executed by a computer:

1) Actually causes the computer to perform the recited method; or

2) Merely "enables" the computer to perform the recited method.

Broadly construed, in the latter case, the instructions appear to encompass the operating system of the computer, stored on a "record carrier" therein; being that the stored operating system "enables" the computer to execute all programs run thereby for performing any given "method".

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3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-7 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. For example, as recently underscored by the circuit court, with reference to past Supreme Court decisions:

“[t]he Supreme Court has recognized only two instances in which such a method may qualify as a section 101 process: when the process ‘either [1] was tied to a particular apparatus or [2] operated to change materials to a ‘different state or thing.’” See PTO Supp. Br. 4 (quoting *Flook*, 437 U.S. at 588n.9). In *Diehr*, the Supreme Court confirmed that a process reciting an algorithm could be statutory subject matter if it: (1) is tied to a machine or (2) creates or involves a composition of matter or manufacture.¹² 450 U.S. at 184.” (Emphasis added)

In re Comiskey, 84 USPQ2d 1670, 1678. (Fed. Cir. 2007)

While the instant claims 1-7 recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. Namely, as currently drafted, the pending claims fail to “tie” any one of the recited steps to disclosed structure. As such, each claim fails to tie the recited method/process to another statutory class. In this regard, it is noted that no “structure” has been recited in any of these claims for performing any one of the recited steps. As such, there is nothing to “tie” the recited method(s) to another statutory category.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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5. Claims 8 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A) The examiner notes that there appear to be two ways the “record carrier comprising a data stream” recitation, set forth in lines 1 of claim 8, can be construed:

1) The first way is that the “record carrier” comprises a storage medium/memory element having the recited data stream/structure recorded thereon. In this case the claim appears to be directed to non-statutory subject matter because, as recited, the “data stream” constitutes non-functional descriptive material;

2) The second way is that the “record carrier” is a signal per se that “carries” the data stream. Signals, per se, are forms of energy and constitute non-statutory subject matter.

In either case, claim 8 is directed to non-statutory subject matter.

B) To the extent that the “record carrier” recitation of claim 9 “comprises” the “instruction per se, i.e. a computer program per se, claim 9 is likewise directed to non-statutory subject matter.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 10 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by notoriously well known universal computing units (e.g., conventional personal computers).

1) The examiner takes Official Notice that universal computing units, such as personal computers, were notoriously well known at the time of applicant's invention.

2) The examiner notes that the "adapted to" recitation set forth in line 2 of claim 10 has been held to broadly encompass the "ability" to perform the recited functions attached thereto.

3) By applicant's own admission conventional universal computing unit, such as personal computers, had the ability to perform the recited functions of claim 10 [note lines 4-9 on page 14 of the instant disclosure].

8. Claim 11 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by notoriously well known universal computing units (e.g., conventional personal computers).

1) The examiner takes Official Notice that universal computing units, such as personal computers, were notoriously well known at the time of applicant's invention.

2) The examiner notes that the "adapted to" recitation set forth in line 2 of claim 10 has been held to broadly encompass the "ability" to perform the recited functions attached thereto.

3) By applicant's own admission conventional universal computing unit, such as personal computers, had the ability to perform the recited functions of claim 11 [note lines 4-9 on page 14 of the instant disclosure].

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9. Claim 9 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by the operating system stored in “record carrier” of a notoriously well known universal computing unit (e.g., conventional personal computers).

1) The examiner takes Official Notice that universal computing units, such as personal computers, were notoriously well known at the time of applicant's invention.

2) The examiner notes that the “adapted to” recitation set forth in line 2 of claim 10 has been held to broadly encompass the “ability” to perform the recited functions attached thereto.

3) By applicant's own admission conventional universal computing unit, such as personal computers, had the ability to perform the recited functions of claim 1 [note lines 4-9 on page 14 of the instant disclosure].

4) The examiner maintains that suggest a stored operating system “enables” the computer to execute any program/method that is programmed into it [note part “C” in paragraph 2 of this Office action].

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsha D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

DAVID E HARVEY
Primary Examiner
Art Unit 2621